



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/700,859	11/04/2003	Young H. Kim	CL1983 US NA	6315
43693 7590 12/08/2008 INVISTA NORTH AMERICA S.A.R.L. THREE LITTLE FALLS CENTRE/1052 2801 CENTERVILLE ROAD WILMINGTON, DE 19808				
EXAMINER				
SERGENT, RABON A				
ART UNIT		PAPER NUMBER		
1796				
NOTIFICATION DATE		DELIVERY MODE		
12/08/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Kathy.L.Crew@invista.com
igrc@invista.com

Office Action Summary

Application No.

10/700,859

Applicant(s)

KIM ET AL.

Examiner

Rabon Sergeant

Art Unit

1796

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte* Quayle, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 9, 10, 12-14 and 17-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9, 10, 12-14, and 17-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 7/21/08
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-7, 9, 10, 12-14, and 17-19 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-19 of

Art Unit: 1796

copending Application No. 10/700,857. Although the conflicting claims are not identical, they are not patentably distinct from each other because each set of claims encompasses the same polyurethane polymer.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-7, 10, 12-14, 17, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Anand et al. ('864).

Patentees disclose polyurethane aqueous dispersions wherein the polyurethane is produced from the reaction of diisocyanates, including aromatic diisocyanates; polyols, including copolymers of tetrahydrofuran and ethylene oxide or propylene oxide; an ionic group-containing reactant, such as dimethylolpropionic acid; and chain extenders, wherein water is a disclosed chain extender. Regarding the polyol component, patentees further disclose that polytetramethylene polyols are preferred, and the position is taken in view of this disclosure that this preference extends to any of the disclosed copolymer polyols derived from tetrahydrofuran, since copolymer polyols derived from tetrahydrofuran are the only type of polytetramethylene polyols disclosed. See abstract; column 7, lines 54+; column 8, lines 1-6, 23, 24, 29-32, and 66+; column 11, lines 13-34; column 12, lines 62+; column 13, lines 59-61; and column 14, lines 1-14. Regarding the use of aromatic diisocyanates, applicants unambiguously disclose at column 7, line 52 that aromatic diisocyanates may be used alone; therefore, the position is taken that the reference clearly teaches an embodiment of the invention that relies solely on the use of aromatic diisocyanates. Furthermore, at column 7, lines 52 and 53, applicants disclose that aromatic diisocyanates may be used in admixture with aliphatic or cycloaliphatic diisocyanates, and the position is taken that this disclosure is adequate to meet applicants' "mixtures thereof" language set forth within line 5 of claims 1 and 10. The examiner has reviewed applicants' specification concerning the disclosure pertaining to mixtures of diisocyanates, and it is noted that applicants nowhere mandate that such mixtures must be exclusively aromatic. In view of the disclosed use of water as chain extender and either the sole use of aromatic diisocyanates or the disclosed termination of the aromatic diisocyanate derived prepolymer with aliphatic or cycloaliphatic isocyanates groups, when mixtures of isocyanates are used, applicants' claimed urea group

content will be realized, since the resulting urea groups will have a structure such that the groups that correspond to applicants' R and R¹ variables will both be either aromatic or aliphatic. The reference is considered to be anticipatory for the rejected claims in view of the fact that only water needs to be selected from the limited group of water and diamine chain extenders and further in view of the fact that specific teachings are provided governing the sole use of aromatic diisocyanates or mixtures thereof.

5. Claims 9 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anand et al. ('864) in view of Berger et al. ('310).

As aforementioned within paragraph 4, the primary reference discloses polyurethaneurea polymers that are considered to meet applicants' claimed polyurethaneurea polymers; however, the primary reference is silent with respect to its composition containing a surfactant. Still, the use of surfactants or emulsifying agents to promote polyurethane dispersion was known at the time of invention as evidenced by the teachings of Berger et al. at column 6, line 60 through column 7, line 69. Therefore, since it has been held *prima facie* obvious to utilize a known compound for its known function, the position is taken that it would have been obvious to incorporate surfactants or emulsifying agents within the polyurethaneurea compositions of the primary reference for their art recognized purpose and function. *In re Linder*, 173 USPQ 356. *In re Dial et al.*, 140 USPQ 244.

6. Applicants' arguments have been considered and addressed within the body of the prior art rejection set forth within paragraph 4. Contrary to applicant's arguments, for the reasons set forth above, the position is taken that Anand et al. allows for the sole use of aromatic diisocyanates or mixtures thereof and that such disclosure is adequate to anticipate the claims.

Art Unit: 1796

Furthermore, the examiner has explained how Anand et al. meet applicants' claim limitations regarding the omission of polyamine chain extenders and the limited content of urea groups having the claimed structure.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.

/Rabon Sergent/
Primary Examiner, Art Unit 1796

R. Sergent
December 3, 2008